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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,996	01/25/2001	Seung-Hyun Nahm	5000-1-156	5422
33942	7590	06/06/2005	EXAMINER	
CHA & REITER, LLC 210 ROUTE 4 EAST STE 103 PARAMUS, NJ 07652			MEHRPOUR, NAGHMEH	
			ART UNIT	PAPER NUMBER
			2686	

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/769,996

Applicant(s)

ENJI HATAZAWA

Examiner

Naghmeh Mehrpour

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 12/6/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-13**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Coad et al. (US Patent 5,966,652) in view of Montgomery et al. (Patent Number 6,798,868 B1).

Regarding **claims 1, 9**, Coad teaches a method for exchanging a message using a short message service (SMS) between a sending party and a receiving party (col 3 lines 15-21), the method comprising the steps of:

creating a text message by said sending party in a first portable digital phone, creating a plurality of optional response messages associated with said text message (col 3 lines 15-21).

Coad fails to teach forwarding said text message with said optional response messages to said receiving party **over the call connection and receiving from the receiving party a return of one of the optional response messages**. However, Montgomery teaches forwarding said text message with said optional response messages to said receiving party **over the call connection** (col 6 lines 25-30, col lines 5-35), and **receiving from the receiving party a return of one of**

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the optional response messages (col 6 lines 42-50). Therefore, it would have been obvious to ordinary skill in the art at the time the invention was made to combine the above teaching of Montgomery with Coad, in order to facilitate call-back, particularly in a case where the called subscriber elects not to interrupt the existing call in response to the waiting the call.

Regarding **claim 2**, Coad teaches a method further comprising the step of, upon receiving the text message, selectively choosing one of the optional response messages by the receiving party in a second portable digital phone (col 3 lines 15-21).

Regarding **claims 3, 13**, Coad fails to teach a method wherein **a message of the optional response message transmitted back to the sending party** includes a call-back number provide by said receiving party. However, Montgomery teaches a method wherein **a message of the optional response message transmitted back to the sending party** includes a call-back number provide by said receiving party (col 6 lines 42-49). Therefore, it would have been obvious to ordinary skill in the art at the time the invention was made to combine the above teaching of Montgomery with Coad, in order to facilitate call-back, particularly in a case where the called subscriber elects not to interrupt the existing call in response to the waiting the call.

Regarding **claim 4**, Coad teaches a text Messaging system wherein the response messages are stored in the memory of the second phone (col 7 lines 30-37).

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Regarding **claim 5**, Coad teaches a method for exchanging a message using a short message service (SMS) (col 6 lines 29-37) between a sending party and a receiving party (col 5 lines 5-19), the method comprising the steps of:

detecting a message having a plurality of optional response messages stored in portable digital phone of the receiving party (col 4 lines 36-38, col 7 lines 64-67, col 8 lines 1-5), the plurality of optional response message is selectively provided by the sending party (col 4 lines 41-44);

selecting one of said optional response messages by said receiving party, forwarding said selected optional response message back to said sending party via said SMS channel (col 6 lines 25-30, lines 5-35);

a text Messaging system wherein the response messages are stored in the memory of the second phone (col 7 lines 30-34), and the plurality of optional response message is selectively provided by the sending party (col 7 lines 25-30).

Regarding **claim 6**, Coad teaches a method of wherein said optional response messages comprise a plurality of items identifying different messages to be selected by said receiving party (col 8 lines 61-67, col 9 lines 1-14, lines 32-38). The call back telephone number itself is display in the form of alphabetic text, for example the text "FOOD" would be converted by the decoder into the digits 3663. Other symbol such as an automobile, travel information, a movie and theater information.

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Regarding **claim 7**, Coad teaches a method wherein the optional message are transmitted to the receiving party by the sending party (col 7 lines 65-66).

Regarding **claim 8**, Coad teaches a method wherein the optional message include a call-back number allowing the selected response entered by the receiving party to be transmitted back to the sending party (col 7 lines 54-66, col 8 lines 1-5).

Regarding **claim 10**, Coad teaches a method wherein the step of storing the text message and the optional response messages in the second terminal upon the text message from the sending party via the SMS channel (col 6 lines 19-37, col 7 lines 64-67, col 8 lines 1-5).

Regarding **claim 11**, Coad teaches a method further comprising the step of retrieving the text message and the optional messages for a provision to the receiving party (col 8 lines 29-35).

Regarding **claim 12**, Coad teaches a method further comprising the step of displaying the retrieved message in a display unit of the second digital terminal (col 7 lines 50-67, col 8 lines 1-9).

Response to Arguments

3. Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. **Any responses to this action should be mailed to:**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naghmeh Mehrpour whose telephone number is 571-272-7913. The examiner can normally be reached on 8:00- 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold be reached (571) 272-7905.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NM

May 17, 2005

Marsha D Banks-Harold
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